

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85817853
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION	
MARK	http://tmng-al.uspto.gov/resting2/api/img/85817853/large
LITERAL ELEMENT	MURAUDIO
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
ARGUMENT(S)	
<p>The Examining Attorney has maintained and made final the refusal of registration of Applicant's mark MURAUDIO for "audio speakers electrostatic loudspeakers and parts and accessories thereof" under Section 2(d) of the Trademark Act because of an alleged likelihood of confusion with the mark in Registration No. 1407448 for the mark WALL for "electrical power supplies, ac/dc and dc/dc converters" and the mark in Registration No. 3218557 for the mark MURR ELECTRONIK for "software for controlling electrical systems and related electrical equipment. (It is noted that the references to applications Serial No. 85679834 for the mark MURA SOUND and Serial No. 85733516 for the mark OHMURA are withdrawn).</p> <p>For the reasons discussed below, Applicant respectfully requests reconsideration and withdrawal of the refusal. Applicant submits that confusion of the instant mark MURAUDIO with these two marks is unlikely due to the respective differences in the marks, the differences in the goods, and the differences in commercial impressions conveyed by the marks, and therefore requests that the refusals be withdrawn.</p> <p>It is also noted, as discussed between the undersigned and the Examining Attorney on May 2, 2016, that Applicant is in the process of obtaining and finalizing consents to registration of the instant mark from the owners of each of the cited registrations; it is expected that said consent documents will be finalized shortly and Applicant will be submitting them as soon as possible in a supplemental submission. As will be seen from the statements in the prospective consents, the third party registrants agree with Applicant's position that there is no likelihood of confusion between the instant mark and the marks in the cited registrations. While Applicant does not believe that it is necessary to submit the consents of registrants in order to overcome the 2(d) refusal, nonetheless, Applicant is obtaining same in order to expedite registration of the instant mark.</p> <p>Turning now to the specifics of the section 2(d) refusal, Applicant submits that there is no likelihood of confusion between MURAUDIO and the marks in the cited registrations for the following reasons.</p> <p>In determining whether a likelihood of confusion exists, the Board analyzes all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. <i>See In re E.I. du Pont de Nemours & Co.</i>, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). <i>See also In re Majestic Distilling Company, Inc.</i>, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). The degree of similarity between conflicting marks is properly determined by the "sight-sound-meaning" trilogy, <i>i.e.</i>, the degree of similarity between marks based on the overall impression created by the designations; pronunciation; translation of foreign words; and verbal translation of pictures; suggestions, connotations or meanings of the designations. Restatement (Third) of Unfair Competition § 21(a) (1995); <i>McCarthy on Trademarks and Unfair Competition</i>, 4th Ed. § 23:21 (2000).</p> <p>In assessing the degree of similarity between marks based on the "sight-sound-meaning" test, it is axiomatic that the mark <i>as a whole</i> must be evaluated. <i>Recot, Inc. v. Becton</i>, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); <i>In re National Data Corp.</i>, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Based on the "sight-sound-meaning" test and viewing Applicant's mark as a whole, there is clearly no likelihood of confusion between the respective marks. Here, Applicant's mark is MURAUDIO while the marks in the cited registrations are WALL and MURR ELECTRONIK.</p>	

The Examining Attorney cited the registration for the mark WALL, as a blocking reference for Applicant's proposed mark MURAUDIO under the doctrine of foreign equivalents. Applicant respectfully asserts that this refusal is unwarranted and should be withdrawn. "Under the doctrine of foreign equivalents, foreign words from common, modern languages are translated into English to determine ... similarity of connotation in order to ascertain confusing similarity with English word marks in a likelihood of confusion analysis." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Although words from modern languages are generally translated into English ... The doctrine of foreign equivalents should be applied only when it is likely that the ordinary American purchaser would 'stop and translate [the word] into its English equivalent.'" *Palm Bay*, 73 USPQ2d at 1696. Application of the doctrine of foreign equivalents turns upon the significance of the foreign mark to the relevant purchasers, which is based on an analysis of the evidence of record, including, dictionary and Internet evidence. *See generally* TMEP § 1207.01(b)(vi) (8th ed. 2011) and the authorities cited therein.

Here, Applicant respectfully submits that consumers will not stop and translate MURAUDIO into the Audio Wall. First of all, Audio Wall is not an English word. While the term wall and the term audio have meanings in English, together they do not have a specific meaning. In support of her position, the Examining Attorney provided a Google translation of the terms "mur" and "audio" which Applicant submits is improper since Applicant's mark is the fanciful word muraudio, not two separate individual words. The Examining Attorney claims that the term "mur" means wall in French, and the term "audio" also means audio in French. Applicant respectfully submits that simply because the first three letters of Applicant's mark may have a meaning in foreign language, does not invoke the doctrine of equivalents. Indeed, the undersigned is advised that the term "MUR" in Applicant's mark MURAUDIO is an abbreviation of the name "Murray" as in the name of Murray Harman, the co-founded of Applicant and the inventor of the technology behind the loud speakers on which the MURAUDIO mark is used.

Even if a consumer did translate Applicant's mark into French, Applicant respectfully asserts that under a 2(d) likelihood of confusion analysis, confusion is not likely with the cited mark WALL for "electrical power supplies and ac/dc and dc/dc converters based on the differences in the translated mark "AUDIOWALL" and WALL. The term AUDIO WALL is quite distinctive from the mark WALL both visually and phonetically. Moreover, Applicant's goods are audio speakers and electrostatic loudspeakers which are quite different from power suppliers and converters. Accordingly, even if the mark was translated, confusion is not likely due to the differences in the marks and their respective goods.

For the reasons discussed above, Applicant submits that the doctrine of foreign equivalents is not applicable in the present case, but even if it is applied, Applicant respectfully submits that confusion with cited registration for the mark WALL is unlikely and requests that this refusal be withdrawn.

Applicant respectfully asserts likewise that the refusal to register based on the cited registration MURR ELECTRONIK should be withdrawn on the basis that there is no likelihood of confusion based on the differences between the marks and the respective goods. It is well established that there is no per se rule that confusion is automatic simply because the marks share a common formative. *See Colgate-Palmolive Company v. Carter Wallace Inc.*, 167 USPQ 529, 530 (CCPA 1970) (finding no likelihood of confusion between PEAK PERIOD for personal deodorants and PEAK for dentrifices); *Lever Brother Co. v. The Barcolene Company*, 174 USPQ 392 (CCPA 1972) (finding no likelihood of confusion between ALL CLEAR for household cleaners and ALL for cleaners). Instead, an analysis under Section 2(d) must be based on the similarity or dissimilarity of the marks viewed as a whole.

The overall appearances of the respective marks MURAUDIO and MURR ELECTONIK are clearly different from one another and it is submitted that Applicant's mark entitled to registration. The fact that the respective marks include the relatively weak formative "MUR" or "MURR", which are not even the same, does not render the marks confusingly similar. *See Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1390, 9 USPQ2d 1736, 1740 (Fed. Cir. 1989) (finding no confusion between PECAN SHORTIES and PECAN SANDIES both for cookies); *see also Consolidated Cigar Corp. v. R.J. Reynolds Tobacco Co.*, 491 F.2d 1265, 1267, 181 USPQ 44, 45 (CCPA 1974) (finding no likelihood of confusion between DUTCH APPLE for pipe tobacco and DUTCH MASTERS for cigars).

As noted previously in this application, a number of "MUR"-containing marks co-exist on the Principal Register, and Applicant has previously invited the Examining Attorney to review the following registrations which all begin with the prefix "mur":

MURALEX, Reg. No. 4326550, for "PVC interlocking interior wall panels not of metal";

MURTEC, Reg. No. 4233488, for "arranging and promoting and conducting trade shows and business conferences for the hospitality industry;

Applicant respectfully asserts that if various third party marks that include the formative MUR, including the two cited registrations for WALL and MURR ELECTRONIK (if MUR and WALL are considered to be equivalents as argued by the Office)— can co-exist, then Applicant's mark should likewise be able to co-exist with the cited registrations.

In addition to confusion being unlikely based on the differences in the marks themselves, confusion is also unlikely based on the differences in the parties' goods. To this point, the TTAB has held that "this Board must compare Applicant's goods as set forth in its application with the goods as set forth in the cited registration *In re Trackmobile, Inc.*, 15 USPQ2d 1152, 1153 (TTAB 1990).

The mere fact that both Applicant and Registrant's goods are in some way related to electrical goods does not in and of itself render confusion likely. In *Checkpoint Systems Inc. v. Check Point Software Technologies Inc.*, 60 USPQ2d 1609 (3rd Cir. 2001), the 3rd Circuit Court of Appeals noted that "goods may fall under the same general product category but operate in distinct niches. When two products are part of distinct sectors of a broad product category, they can be sufficiently unrelated that consumers are not likely to assume the products originate from the same mark." In *Check Point* the Court ultimately found that CHECK POINT when used for computer security firewall technology was not likely to cause confusion as to the source of security monitoring services which was also marketed under the service mark CHECKPOINT "because the products serve different functions, and [since] there is only 'minimal overlap' in the product technology, it is unlikely consumers would be confused by the similar marks.

In another case, *Best Flavors Inc. v. Mystic River Brewing Co.*, 36 USPQ2d 1247 (D. Me. 1995), the District Court of Maine found that consumers were not likely to confuse MYSTIC SEAPORT as used on alcoholic beverages with MYSTIC as used on non-alcoholic beverages because "alcoholic and nonalcoholic beverages are distinct commodities in our culture...consumers are consciously aware of whether they are choosing an alcoholic or a nonalcoholic beverage."

Similarly, in the instant case, the parties' respective goods are very different and distinguishable from one another and consequently do not compete in the market. Applicant's products and Registrants' goods have different purposes, travel in different trade channels and attract different customers. For example, Applicant's goods are offered to customers wishing to purchase audio loud speakers, while Registrants' goods are respectively electrical power supplies and ac/dc converters ('448 registration) and software for controlling electrical systems, etc ('557 registration). Registrants' goods are therefore all very different from the audiospeakers offered by Applicant and are offered to very different consumes and travel is very different channels of trade.

For all the foregoing reasons, Applicant respectfully requests that refusal to register the instant mark based on Section 2(d) of the Trademark Act be reconsidered and withdrawn and that the instant application be approved for publication.

ADDITIONAL STATEMENTS SECTION

MISCELLANEOUS STATEMENT	Applicant has been asked to submit a translation to the effect that "MUR AUDIO" is "WALL AUDIO"; however, for the reasons set forth herein, Applicant submits that such translation is not proper (since the Applicant's mark is MURAUDIO) and therefore requests reconsideration and withdrawal of this requirement.
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SIGNATURE SECTION

RESPONSE SIGNATURE	/marilyn matthes brogan/
SIGNATORY'S NAME	Marilyn Matthes Brogan
SIGNATORY'S POSITION	attorney
SIGNATORY'S PHONE NUMBER	212 588 0800
DATE SIGNED	05/03/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES

FILING INFORMATION SECTION

SUBMIT DATE	Tue May 03 14:09:29 EDT 2016
TEAS STAMP	USPTO/RFR-XX.XXX.XXX.X-20 160503140929595599-858178 53-550671a3549c3678815c75 4f8783d3b6a9bd6c6ffd57c41 cf6213f7374587ce3e2-N/A-N /A-20160503135638189838

To the Commissioner for Trademarks:

Application serial no. **85817853** MURAUDIO(Standard Characters, see <http://tmng-al.uspto.gov/resting2/api/img/85817853/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Examining Attorney has maintained and made final the refusal of registration of Applicant's mark MURAUDIO for "audio speakers electrostatic loudspeakers and parts and accessories thereof" under Section 2(d) of the Trademark Act because of an alleged likelihood of confusion with the mark in Registration No. 1407448 for the mark WALL for "electrical power supplies, ac/dc and dc/dc converters" and the mark in Registration No. 3218557 for the mark MURR ELECTRONIK for "software for controlling electrical systems and related electrical equipment. (It is noted that the references to applications Serial No. 85679834 for the mark MURA SOUND and Serial No. 85733516 for the mark OHMURA are withdrawn).

For the reasons discussed below, Applicant respectfully requests reconsideration and withdrawal of the refusal. Applicant submits that confusion of the instant mark MURAUDIO with these two marks is unlikely due to the respective differences in the marks, the differences in the goods, and the differences in commercial impressions conveyed by the marks, and therefore requests that the refusals be withdrawn.

It is also noted, as discussed between the undersigned and the Examining Attorney on May 2, 2016, that Applicant is in the process of obtaining and finalizing consents to registration of the instant mark from the owners of each of the cited registrations; it is expected that said consent documents will be finalized shortly and Applicant will be submitting them as soon as possible in a supplemental submission. As will be seen from the statements in the prospective consents, the third party registrants agree with Applicant's position that there is no likelihood of confusion between the instant mark and the marks in the cited registrations. While Applicant does not believe that it is necessary to submit the consents of registrants in order to overcome the 2(d) refusal, nonetheless, Applicant is obtaining same in order to expedite registration of the instant mark.

Turning now to the specifics of the section 2(d) refusal, Applicant submits that there is no likelihood of confusion between MURAUDIO and the marks in the cited registrations for the following reasons.

In determining whether a likelihood of confusion exists, the Board analyzes all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). The degree of similarity between conflicting marks is properly determined by the "sight-sound-meaning" trilogy, *i.e.*, the degree of similarity between marks based on the overall impression created by the designations; pronunciation; translation of foreign words; and verbal translation of pictures; suggestions, connotations or meanings of the designations. Restatement (Third) of Unfair Competition § 21(a) (1995); *McCarthy on Trademarks and Unfair Competition*, 4th Ed. § 23:21 (2000).

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ADDITIONAL STATEMENTS

Miscellaneous Statement

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SIGNATURE(S)

Request for Reconsideration Signature

Signature: /marilyn matthes brogan/ Date: 05/03/2016

Signatory's Name: Marilyn Matthes Brogan

Signatory's Position: attorney

Signatory's Phone Number: 212 588 0800

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85817853

Internet Transmission Date: Tue May 03 14:09:29 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.XXX.X-20160503140929595

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